

REMARKS/ARGUMENTS

Reconsideration and allowance of the present application based on the following remarks are respectfully requested.

Upon entry of this amendment, claims 1, 3-5, and 7-20 will be pending of which claims 1, and 15 remain as independent claims and claims 4, 8 and 10 are re-written as independent claims. Claim 14 is amended. Claims 21 and 22 are canceled. The amendment in claim 14 is stylistic, and the amendments to claims 4, 8 and 10, merely incorporate the limitations from claim 1, therefore, the applicants believe that no new matter has been added as a result of these amendments.

Applicants note with appreciation that claims 4, 8, 10 and 17 are merely objected to as depending from a rejected base claim. Accordingly, since claims 4, 8 and 10 are now re-written in independent form, including all of the limitations of the parent claim, claims 4, 8 and 10 are believed to be in condition for allowance.

It is noted, in addition, however, that claim 5 depends from claim 4. Therefore, claim 5 is also believed to be in condition for allowance.

However, for at least the reasons set forth below, it is believed that all pending claims are in condition for allowance.

Claims 1 and 12 were rejected for containing the term "solution styrene/butadiene." This term is deleted and the suggested phrase "solution polymerized styrene-butadiene copolymer" is added in its place. Accordingly, this rejection is now moot.

The applicants respectfully request reconsideration and allowance of the present application. This amendment is filed within the statutory period for response along with the fee for a one-month extension of time.

Claims 1, 3, 9, 11-15, and 18-20 were rejected as allegedly obvious over Scholl (U.S. Pat. No. 5,834,536) in view of Scholl *et al.* (U.S. Pat. No. 5,650,457). This rejection is moot in view of the amendments to the claims.

As amended, claims 1, 3, 9, 11-15, and 18-20 are directed to, *inter alia*, a rubber mixture in which the organosilanes of the structure (I) include a Z group which is H, SCN, SH or $S_xR^4-SiR^1R^2R^3$. In contrast in Scholl *et al.*, only halogenated alkyl silanes are disclosed. Therefore, since the cited references fail to disclose organosilanes of the general structure (I) as set forth in all of the rejected claims, the pending claims would not have been

prima facie obvious over Scholl in view of Scholl *et al.* and the applicants respectfully request removal of this rejection.

The cancellation of claims 21 and 22 removes the rejection of those claims as unpatentably obvious over Childress *et al.* (U.S. Pat. No. 5,489,701).

Claims 1, 3, 5, 7, 9, 11-16 and 18-22 are rejected as unpatentably obvious over Ohta *et al.* (U.S. Pat. No. 6,489,389) in view of Childress *et al.* Reconsideration and withdrawal of this rejection is kindly requested.

It is respectfully submitted that one of ordinary skill in the art would not have been motivated, given the clear preference by Ohta *et al.* for trialkoxy silane derivatives, with only brief mention of silane coupling agents wherein the "Y" groups are different and then to only to dialkoxymonoalkyl compounds (*see, e.g.*, col. 8, lines 10-19), to replace the preferred silane agents by anything other than the preferred end product, 3,3'-bis(triethoxysilylpropyl) tetrasulfide (*see, e.g.*, Abstract, col. 2, lines 65-67; col. 3, lines 38-48).

The examiner has suggested that the combination is obvious since Ohta *et al.* since the patentees exemplify mixed alkyl- and alkoxy-substituted silanes. However, it is noted that these are all dialkoxymonoalkyl-substituted silanes. While this difference has been characterized as differing only in the permutation of ethoxy and methyl groups, it is respectfully submitted that in view of the clear preference for trialkoxymonoalkyl substituted silanes and the mere disclosure of only mixed alkoxy-alkyl silanes which include two alkoxy substituents, it is not a mere matter of permutation of ethoxy and methyl groups but rather a clear departure from the disclosure to arrive at dimethylethoxy substituted silane compounds based on the disclosure of Ohta *et al.* Therefore, since there is nothing in the disclosure of Childress *et al.* which would lead the practitioner to deviate from the preference in each of the cited references for trialkoxy silane compounds, it is respectfully submitted that the subject matter presently claimed in claims 1, 3, 5, 7, 9, 11-16 and 18-22 would not have been *prima facie* obvious over Ohta *et al.* in view of Childress *et al.*

Still further, the Examiner is referred to the results reported in Table 3 on page 11 of the specification. In this table Example 1 is based on a trialkoxysilane coupling agent whereas Example 2 is based on a dimethylethoxysilane coupling agent. The data in Table 3 shows that the latter provides substantial improvements with respect to at least rolling

resistance while not impairing other properties. These results would not have been expected in view of the prior art.

Therefore, all objections and rejections having been addressed, it is respectfully submitted that the present application is in a condition for allowance and a Notice to that effect is earnestly solicited.

Should any issues remain unresolved, the Examiner is encouraged to contact the undersigned attorney for Applicants at the telephone number indicated below in order to expeditiously resolve any remaining issues.

Respectfully submitted,

PILLSBURY WINTHROP LLP

By: 

Thomas A. Cawley, Jr., Ph.D.
Registration No. 26,588
Direct No. (703) 905-2144

Richard A. Steinberg
Registration No. 26,588

P.O. Box 10500
McLean, VA 22102
(703) 905-2000 Telephone
(703) 905-2500 Facsimile

Date: April 16, 2004